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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,250	01/31/2001	Geoffrey D. Ralston	17887007100	4342

20350 7590 04/06/2004

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EXAMINER	
KENNEDY, LESA M	

ART UNIT	PAPER NUMBER
2151	7

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,250	RALSTON ET AL.	
	Examiner	Art Unit	
	Lesa Kennedy	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 January 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5 and 6*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. This action is responsive to the application filed on January 31, 2001. Claims 1-20 are pending examination. Claims 1-20 are directed towards a method for processing bulk electronic text messages.

2. The following claims contains grammatical errors::

- Claim 5 (line 2)
- Claim 11 (line 2)
- Claim 20 (line 2)

Appropriate correction is recommended.

Drawings

3. The drawings are objected to because :

- There is no reference to Fig. 5F in the specification.
- Fig. 7A is incomplete. The resulting action when the response to step 732 is 'yes' is not displayed in the figure.
- Fig. 12 indicates that an action takes place after step 1224, but this action is not displayed in the figure or discussed in the specification.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because it does not describe the claimed subject matter of the dependent claims. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites being dependent on itself. For purposes of further reviewing this claim, it will be assumed that the applicant intended to state that claim 15 is dependent on claim 14. It will also be assumed that claims 16-20 depend on claim 14, not claim 15. Applicant is reminded to amend claims 15-20 to have the proper dependencies.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Cotten (U.S. Patent No. 6,330,590).

As to claim 1, Cotten teaches a method comprising:

receiving a first electronic and a second electronic submission (col. 3, lines 21-35; Cotten discloses comparing the signature identification codes of a previously sent bulk e-mail message (first electronic submission) and a current e-mail message (second electronic submission));

extracting a first portion from the first electronic submission and a second portion from the second electronic submission (col. 3, lines 61-65; Cotten discloses extracting the text portion of all messages);

determining a first code for the first portion and a second code for the second portion, wherein the first code is indicative of the first portion and the second code is indicative of the second portion (col. 3, lines 64-67; Cotten discloses identifying and coding the individual message signature for each extracted text portion);

comparing the first code to the second code (col. 3, lines 21-35; Cotten discloses comparing the signature identification codes of a previously sent bulk e-mail message (first code) and an incoming e-mail message (second code)); and

filtering the second electronic submission in response to comparing the first code to the second code (col. 3, lines 31-35; Cotten discloses deleting (filtering) a current message (second electronic submission) if its signature code (second code) matches a stored signature code (first code)).

As to claim 3, Cotten teaches the method of claim 1, wherein the first portion is extracted from visible text in the first electronic submission (col. 3, lines 61-65; Cotten discloses extracting the text portion of all messages).

As to claim 5, Cotten teaches the method of claim 1, wherein the first portion is related to the first code by one of a hash function, a checksum and a cyclic redundancy check (CRC) (col. 2, lines 28-30; Cotten discloses that each signature identification code is generated by a checksum using a cyclic redundancy check).

As to claim 6, Cotten teaches the method of claim 1, wherein each of the first and second codes is represented in less bits than a corresponding portion (col. 3, lines 65-67; Cotten discloses that the signatures are coded in abbreviated format).

As to claim 7, Cotten teaches the method of claim 1, wherein the first and second electronic submissions are chosen from the group consisting of an electronic mail message, a chat room comment, an instant message, a newsgroup posting, an electronic forum posting, a message board posting, and a classified advertisement (col. 3, line 21; Cotten discloses blocking e-mail messages).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2, 4 and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotten in view of McCormick et al. (U.S. Patent No. 6,421,709).

As to claim 2, Cotten teaches the invention substantially as claimed (see rejection of claim 1 above).

Cotten fails to teach the limitation of storing the second electronic submission in a bulk mail folder.

However, McCormick teaches of storing an electronic submission in a bulk mail folder (col. 5, lines 10-14; McCormick discloses filtering an incoming e-mail message and sending it to a Waiting Room folder (bulk mail folder)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of McCormick so as to store e-mails that cannot be classified as wanted or unwanted in a separate folder. One would be motivated to do so to enable the mail recipient to determine the significance of the e-mail and to update the filtering system about new unsolicited e-mails.

As to claim 4, Cotten teaches the invention substantially as claimed (see rejection of claim 1 above).

Cotten fails to teach the limitations of modifying a count in response to the comparing of the first code with the second code; determining if the count reaches a threshold; comparing a third code associated with a third message; and filtering the third message if the third code matches the second code.

However, McCormick teaches the limitations of:

modifying a count in response to the comparing of the first code with the second code (col. 9, lines 33-37; McCormick discloses incrementing a counter if a new message (second code) matches a store spam message (first code));

determining if the count reaches a threshold (col. 9, lines 38-41; McCormick discloses determining if the counter is greater than or equal to a threshold);

comparing a third code associated with a third message (col. 9, lines 33-44; McCormick discloses filtering a new e-mail (third message) with the same spam message once the counter reaches a threshold); and

filtering the third message if the third code matches the second code (col. 9, lines 33-44; McCormick discloses filtering a new e-mail (third message) with the same spam message once the counter reaches a threshold).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of McCormick so as to filter future sendings of an unsolicited e-mail once a predetermined number of that unsolicited e-mail has been received. One would

be motivated to do so to prevent inappropriate filtering due to improper identification of unsolicited e-mails by users.

As to claim 8, Cotten teaches a method comprising:

receiving a first electronic submission (col. 3, lines 26-31; Cotten discloses storing the signature identification code for a currently active bulk mail message (first electronic submission);

extracting a first portion from the first electronic submission (col. 3, lines 61-65; Cotten discloses extracting the text portion from each message to generate an individual message signature);

determining at least a first code for the first portion, wherein the first code is indicative of the first portion (col. 3, lines 65-67; Cotten discloses coding the signature for each message);

receiving a second electronic submission (col. 3, lines 31-35; Cotten discloses an incoming message (second electronic submission));

extracting a second portion from the second electronic submission (col. 3, lines 61-65; Cotten discloses extracting the text portion from each message to generate an individual message signature);

determining at least a second code for the second portion, wherein the second code is indicative of the second portion (col. 3, lines 65-67; Cotten discloses coding the signature for each message), and

comparing the first code with the second code (col. 3, lines 31-35; Cotten discloses comparing a current message's code (second code) with a stored signature code (first code)).

Cotten fails to teach the limitations of modifying a count in response to the comparing of the first code with the second code; determining if the count reaches a threshold; and filtering subsequent electronic submissions similar to the first electronic submission in response to determining if the count reaches the threshold.

However McCormick teaches the limitations of:

modifying a count in response to the comparing of the first code with the second code (col. 9, lines 33-37; McCormick discloses incrementing a counter if a new message (second code) matches a store spam message (first code));

determining if the count reaches a threshold (col. 9, lines 38-41; McCormick discloses determining if the counter is greater than or equal to a threshold); and

filtering subsequent electronic submissions similar to the first electronic submission in response to determining if the count reaches the threshold (col. 9, lines 33-44; McCormick discloses filtering messages (subsequent electronic submissions) with the same spam message once the counter reaches a threshold).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of McCormick so as to filter future sendings of an unsolicited e-mail once a predetermined number of that unsolicited e-mail has been received. One would be motivated to do so to prevent inappropriate filtering due to improper identification of unsolicited e-mails by users.

Claims 9 and 11-13 represent method claims that correspond to claims 2 and 5-7, respectively. They do not teach or define any new limitations above claims 2 and 5-7, and therefore are rejected for similar reasons.

As to claim 10, the combination of Cotten in view of McCormick teaches the method of claim 8, wherein the first and second codes are each a number represented in a same number of bits (col. 2, lines 28-30; Cotten discloses generating each signature identification code using a 16-bit cyclic redundancy check).

As to claim 14, Cotten teaches a method comprising:

receiving a first electronic submission (col. 3, lines 26-31; Cotten discloses storing the signature identification code for a currently active bulk mail message (first electronic submission);

extracting a first portion from the first electronic submission (col. 3, lines 61-65; Cotten discloses extracting the text portion from each message to generate an individual message signature);

determining at least a first code for the first portion, wherein the first code is indicative of the first portion (col. 3, lines 65-67; Cotten discloses coding the signature for each message);

receiving a second electronic submission (col. 3, lines 31-35; Cotten discloses an incoming message (second electronic submission));

extracting a second portion from the second electronic submission (col. 3, lines 61-65; Cotten discloses extracting the text portion from each message to generate an individual message signature);

determining at least a second code for the second portion, wherein the second code is indicative of the second portion (col. 3, lines 65-67; Cotten discloses coding the signature for each message), and

comparing the first code with the second code (col. 3, lines 31-35; Cotten discloses comparing a current message's code (second code) with a stored signature code (first code)).

Cotten fails to teach of each portion comprising a plurality of portions, and generating a plurality of codes indicative of its respective portion. Cotten also fails to teach the limitations of modifying a count in response to the comparing of the first plurality of codes with the second plurality of codes; determining if the count reaches a threshold; and filtering similar electronic submissions in response to determining if the count reaches a threshold.

However McCormick teaches of each portion comprising a plurality of portions (col. 4, lines 47-50; McCormick discloses searching the body of a message for different character strings (plurality of portions). This would lead to the generation of a plurality of codes based Cotten's disclosure). McCormick also teaches:

modifying a count in response to the comparing of the first plurality of codes with the second plurality of codes (col. 9, lines 33-37; McCormick discloses incrementing a counter if a new message (second plurality of codes) matches a store spam message (first plurality of codes));

determining if the count reaches a threshold (col. 9, lines 38-41; McCormick discloses determining if the counter is greater than or equal to a threshold); and

filtering similar electronic submissions in response to determining if the count reaches a threshold (col. 9, lines 33-44; McCormick discloses filtering messages with the same spam message once the counter reaches a threshold).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of McCormick so as to 1) filter future sendings of an unsolicited e-

mail once a predetermined number of that unsolicited e-mail has been received, and 2) search a message for several different character strings. One would be motivated to do so 1) to prevent inappropriate filtering due to improper identification of unsolicited e-mails by users, and 2) to search the message for known advertisement information that cannot be altered to disguise the unsolicited mail.

Claims 15 and 17-20 represent method claims that correspond to claims 2, 5, 7, 10 and 6, respectively. They do not teach or define any new limitations above claims 2, 5, 7, 10 and 6 and therefore are rejected for similar reasons.

As to claim 16, the combination of Cotten in view of McCormick teaches the method of claim 14, comprising determining if a percentage of the first plurality of codes exactly matches one of the second plurality of codes (col. 4, lines 60-64; McCormick discloses determining if any of the stored character strings (first plurality of codes) matches a character string (one of the second plurality of codes) in an incoming message).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lesa Kennedy whose telephone number is (703) 305-8865. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Lesa Kennedy
Art Unit 2151

Andrew Caldwell